

Application Serial No. 10/706,749
Reply to Office Action of July 25, 2006

OCT 10 2006

PATENT
Docket: CU-3447

REMARKS/ARGUMENTS

Claims 1-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Park (U.S. patent 6,044,057) and Kim et al., (U.S. publication 2001/0012261). The applicant objects to the rejection made under 35 U.S.C. §103(a) because it was made improperly.

As the examiner knows, a determination that a claimed combination would have been obvious is a legal conclusion that must be based on factual determinations that were articulated in *Graham v. Deere*. The office action is wholly devoid of any factual determinations. The putative bases for rejecting the claims are set forth in the examiner's wholly conclusory statement that:

"it would have been obvious to one of ordinary skill in the art...to provide Park et al. with flange portions [having] end portions that only encircle about half of the adjustment cam, as taught by Kim et al., because, if the adjustment groove portion, then there can be a physical barrier at the end portions of the cam portion." (Misspellings in original text.)

The Court of Appeals for the Federal Circuit has said many times that when all of a claim's limitations are found in a number of prior art references, a fact finder must determine what the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references."¹ In the examination process, the fact finder is the examiner. In the office action, however, none of the *Graham v. Deere* factors were considered, particularly the suggestion or motivation to combine Park and Kim.

There is no suggestion in either Kim or Park to combine them as the examiner has done. The suggestion to combine references, however, need not come from the references themselves but may also come from elsewhere in the prior art. Unfortunately for the applicant, the examiner did not bother to find any motivation or teaching to combine Kim and Park. Indeed, it appears that the only suggestion to combine Kim and Park was the applicant's claims, however,

¹ See *Dystar Textilfarben GMBH v C.H. Patrick Co.*, Fed. Cir., 2006 quoting *In re Fulton*, 391 F.3d 1195, 1199-1200 (Fed. Cir. 21004).

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even the MPEP states that motivation to combine references cannot come from the applicant's disclosure. See MPEP §706.02(j).

The office action issued by the examiner is wholly devoid of any discussion or consideration of obviousness under the *Graham v. Deere* factors. The rejection under 35 U.S.C. §103(a) is based entirely on factually unsupported and therefore legally improper conclusions. The rejection under §103(a) was legally improper and must be withdrawn.

Notwithstanding the impropriety of the rejection, claim 1 has been amended to further clarify the claimed subject matter. Paraphrased, claim 1 now recites that the flange members on the height adjustment cam do not go all the way around the height adjustment cam. More particularly, the flange members provide a gap through which the guiding rod is moveable in the direction of the axis of rotation of the height adjustment portion. This gap allows the device to be easily assembled.

As can be seen in FIG. 3 of the Kim reference, and as stated in paragraph [0022] of the Kim reference, the adjustment cam 210 of Kim has a cam groove 211 "into which the...guide shaft 170 is inserted...[and] as the cam member 210 rotates...the guide shaft 170 slides along the cam groove 211 and can ascend and descend." In the office action, the examiner said that the cam groove 211 provides a physical barrier and that the cam groove allows the adjustment cam to rotated only by a given amount. Thus, the examiner ostensibly rationalized the Kim and Park combination because the cam groove of Kim provide some sort of desirable result, embodied as a restricted movement of the cam.

As claim 1 has been amended, the partial circumferential gap in the first and second flange portions is recited as allowing the guiding rod to be moveable in a direction that is parallel to the axis of rotation of the height adjustment portion, which is a structural limitation that neither Park nor Kim can satisfy. Claim 1 as amended avoids the Park and Kim references and is in condition for allowance. Support for the amendment to claim 1 is found in the

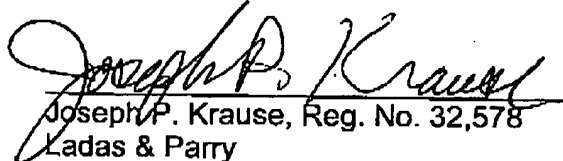
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figures as well as the specification text on at least pages 9 and 10. No new matter has been added.

Respectfully submitted,

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